

Group III: Claims 7-10 and (12-13)/(7-9), drawn to a method of protecting film by forming a fluoride layer from a gaseous substance in a vacuum;

Group IV: Claims 11 and (13-13)/11, drawn to a method of making a protecting film utilizing a paste or dispersion;

Group V: Claims 16-17, drawn to a composition; and

Group VI: Claims 19-20, drawn to a method of making protecting film by forming a powder layer and then treating the surface.

Applicants have elected Groups I and II, Claims 1, (3-6)/1, and 18/1 and Claims 2, (3-6)/2, and 18/2 with traverse.

Applicants submit that Claim 2 introduces further specifics of the fluoride layer envisioned by the genus embodied in Claim 1. The fact that the fluoride layer may be a powder qualifies it as a species of this genus. Therefore, there is no way that these can be held to be patentably distinct. Applicants submit that if the Examiner maintains the Restriction Requirement between Groups I and II, the Applicants shall petition.

In regard to Groups I and III, the Office has characterized the relationship between these two groups as "process of making and product made." Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process such as "by dispersion coating a fluoride layer." However, there is no evidence of record to show that the claimed products could be made as the Office has alleged. If, in fact, the claimed product can be made by a process, the Office has failed to show that the alleged process of using "dispersion coating a fluoride layer" is materially different from the claimed process. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Citing MPEP §806.04 and MPEP §808.01, the Office has characterized the inventions of Groups I and IV as unrelated. According to MPEP 808.01, if inventions are held unrelated, it must be shown that they are not disclosed as capable of use together. However, the Office alludes to such a process in its Restriction between Groups I and III. Therefore, if the Office maintains its allegation in the Restriction between Groups I and III, then these groups must be related. Furthermore, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Thus, the Office has not made out a proper restriction requirement. The Office has failed to meet the burden necessary in order to sustain the Restriction Requirement and it should be withdrawn.

The Office has characterized the inventions of Groups I and V as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the different inventions have different effects.” However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups I and VI, II and III, and II and VI as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the method of Group (VI, III, and VI) does not produce the product of Group (I, II, and II, respectively).” However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups IV and II as related as process of making and product made. Citing MPEP §806.05(f), the Office concludes that the product as claimed can be made by a different process "such as by lamination of individual preformed films." However, there is no evidence of record to show that the claimed product can be made by such a process as the Office has alleged. If in fact the claimed product can be made by a process "such as by lamination of individual preformed films," Applicants respectfully submit that the Office has not shown how the alleged process is materially different from the claimed process. Accordingly, Applicants respectfully request withdrawal of the Restriction Requirement.

The Office has characterized the inventions of Groups V and II as mutually exclusive species in an intermediate-final product relationship. Citing MPEP §806.04(b), third paragraph, the Office states that the intermediate product is useful "as a molding composition for a self-support article." The Office furthermore cites MPEP §806.04(h) in support of its assertion that the inventions are deemed patentably distinct on the ground that there is nothing on record to show them to be obvious variants. Applicants respectfully traverse the Restriction Requirement on the grounds that there is no evidence of record to conclude that the intermediate products are useful as the Office has suggested. Moreover, Applicants respectfully submit that the burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and is not on the Applicants to establish that they are not. Accordingly, the Restriction Requirement is believed to be improper, and it should be withdrawn.

The Office has characterized the inventions of Groups III and IV as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that "the inventions have different modes of operation". However, the Office has not provided sufficient reasons and/or

examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups III and V as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the inventions have different functions”. However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups III and VI as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the inventions have different modes of operation”. However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups IV and Groups V as related as product and process of use. The Office states that the product may be used as “a pigment or filler material in a molding process.” However, there is no evidence of record to show that the claimed product are useful as the Office has alleged. In addition, the Office has failed to show that its alleged use of the claimed product as “a pigment or filler material in a molding process” is materially different from what is claimed. Accordingly, Applicants respectfully

submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

The Office has characterized the inventions of Groups IV and VI as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “the inventions have different modes of operation”. However, the Office has not provided sufficient reasons and/or examples to support this assertion. The Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

The Office has characterized the inventions of Groups V and VI as unrelated. Citing MPEP §806.04 and MPEP §808.01, the Office concludes that “method of Group IV does not utilize a paste or dispersion comprising a solvent and a binder as in Group V”. However, the Office has not provided sufficient reasons and/or examples to support this assertion, particularly in light of the “comprising” language which allows for the use of a paste or dispersion as in Group V. Therefore, Office has merely stated the conclusion. Accordingly, the Office has failed to meet the burden necessary in order to sustain the Restriction Requirement. Accordingly, Applicants respectfully submit that the Restriction Requirement should be withdrawn.

Applicants respectfully traverse on the additional grounds that the Office has not provided an adequate reason or example to support a conclusion of patentable distinctness, or shown that a burden exists in searching the entire application.

Further, MPEP §803 states as follows:

If the search and examination of an entire application can be made without serious burden, the Examine must examine it on its merits, even though it includes claims to distinct or independent inventions.

Applicants submit that a search of all claims would not constitute a serious burden on the Office.

For the reasons set forth above, Applicants contend that the Restriction Requirement is improper and should be withdrawn.

Additionally, MPEP §821.04 states:

...if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.

Applicants respectfully submit that should the elected group be found allowable, non-elected should be rejoined.

Applicants further submit that this application is now in condition for examination on the merits and an early notification to that effect is earnestly solicited.

Respectfully submitted,
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